

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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| Applicant | : | ZIMMERMAN, John |
| Serial No. | : | 09/597,196 |
| Filed | : | June 20, 2000 |
| For | : | TOKEN-BASED PERSONALIZATION OF SMART APPLIANCES |
| Group Art Unit | : | 2444 |
| Examiner | : | SHINGLES, Kristie D. |
| Confirmation | : | 6011 |

**BRIEF FOR APPEAL UNDER 37 CFR 41.37; AND PETITION FOR EXTENSION
OF TIME UNDER 37 CFR 1.136 IN U.S. PATENT APPLICATION NO. 09/597,196**

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

This Brief is submitted on appeal under 35 U.S.C. § 134 from the Final Rejection in the Office Action dated April 1, 2009, of claims 5, 7, 9, 10, and 12-25 of U.S. Patent Application No. 09/597,196.

A Notice of Appeal was filed on August 3, 2009. Applicant hereby petitions under 37 C.F.R. 1.136 for an extension of time of 4 months to extend the deadline for submission of this Brief to **Tuesday, February 3, 2010**. Payment of the applicable extension fee and the fee for filing a brief in support of an appeal (pursuant to 37 CFR §§ 1.27(a) and 41.20), is made concurrently herewith.

REAL PARTY IN INTEREST

The real party in interest in this appeal is the assignee of record Koninklijke Philips Electronics N.V., a corporation of the Netherlands having an office and a place of business at Groenewoudseweg 1, Eindhoven, Netherlands 5621 BA.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to applicant, applicant's legal representative, or the assignee, that will directly affect, will be directly affected by, or will have a bearing on the Board's decision in this appeal.

STATUS OF CLAIMS

Claims 5, 7, 9, 10, and 12-25 are pending in the present application. Claims 1-4, 6, 8, and 11 are canceled.

In the April 1, 2009 Final Office Action, all pending claims 5, 7, 9, 10, 12-25 were finally rejected under 35 U.S.C. § 103(a). Rejected claims 5, 7, 9, 10, and 12-25 are the subject of this appeal.

A copy of the appealed claims is provided in enclosed Claims Appendix.

STATUS OF AMENDMENTS

Applicant filed a Response to the April 1, 2009 Final Office Action on May 29, 2009 that included amendments to independent claims 5, 9, and 14, and amendments to dependent claim 7. The claim amendments were considered and entered by the examiner as indicated in the Advisory Action mailed on July 14, 2009. A copy of the appealed claims as amended on May 29, 2009 is provided in the enclosed Claims Appendix.

SUMMARY OF CLAIMED SUBJECT MATTER¹

The independent claims pending in the present application are claims 5, 9, and 14. Pending claims 7, 10, 12, 13, and 15-25 are dependent claims.

Independent claim 5, and dependent claims 18-20, are directed to an appliance² including a controller³ and a receiver⁴ connected thereto⁵, being effective to receive a device identifier⁶ from a remote communications device⁷; and a network interface⁸ connectable to an external relay server⁹ corresponding to the device identifier¹⁰; the controller being configured to: transmit data corresponding to the device identifier to the relay server¹¹, receive a profile address in response from the relay server¹², transmit a request to an external profile server at the profile address¹³, receive one or more user preferences from the profile server¹⁴, and control the appliance based on the one or more user preferences¹⁵.

Independent claim 9, and dependent claims 7, 10, 12-13, and 21-25, are directed to a method of controlling the operation of an appliance, the method including: receiving, at the appliance, first access data¹⁶ from memory of a first remote device¹⁷, the first access data providing network access to first configuration data corresponding to a first set of user preferences on an external network¹⁸; receiving at the appliance at least a portion of the first configuration data via the network access¹⁹; configuring the appliance to a first configuration in accordance with at least a portion of the first

¹ It is respectfully noted that it is not the appellants' intention that the claimed embodiments of this invention be limited to operation within the example embodiments described in this brief, beyond what is required by the claim language. These examples and their description are provided to facilitate ease of understanding and to comply with the requirements of an appeal brief, without intending that any further interpreted limitations be read into the claims as presented.

² E.g., specification, ll. 14-19, page 1, ll. 3-5, page 6, ll. 20-22, page 16, ll. 10-12, page 20, and FIG. 3.

³ E.g., specification, ln. 4, page 19.

⁴ E.g., specification, FIG. 3 and claim 5.

⁵ E.g., specification, FIG. 3 and ll. 2-6, pg. 19.

⁶ E.g., claim 5.

⁷ E.g. specification, ll. 12-21, page 20, and ll. 21-23, page 20.

⁸ E.g. specification, ll. 2-20, page 19, and ll. 3-14, page 21, FIG. 3, and claim 5.

⁹ E.g. specification, ll. 4-6, page 5, and claim 5.

¹⁰ E.g. specification, ll. 3-14, page 21, FIG. 3, and claim 5.

¹¹ E.g. specification, ll. 16-21, page 20, and FIG. 4.

¹² E.g. specification, ll. 21-23, page 20, and FIG. 4.

¹³ E.g. specification, ln. 23, page 20 – ln. 2, page 21, and FIG. 4.

¹⁴ E.g. specification, ll. 2-11, page 21, ln. 15, page 21 – ln. 1, page 22, and FIG. 4.

¹⁵ E.g. specification, ll. 3, page 9 – ln. 18, page 10, ln. 7, page 20 – ln. 1, page 22, claim 5, and FIG. 4-11.

¹⁶ E.g. specification, ll. 4-5, page 5, ll. 7-15, page 20, and claim 9.

¹⁷ E.g., specification, ln. 2, page 5 – ln. 1, page 6, and ll. 7-9, page 20.

¹⁸ E.g., specification, ll. 1-7, page 5, ll. 16-23, page 20, and claims 6-9 as originally filed.

¹⁹ E.g., specification, ll. 7-15, page 5, ll. 2-11, page 21, and claims 6-9 as originally filed.

configuration data²⁰; receiving, at the appliance, second access data to the appliance from a memory of a second remote device²¹, the second access data providing network access to second configuration data corresponding to a second set of user preferences on the external network²²; receiving at the appliance at least a portion of the second configuration data via the network access²³; and reconfiguring the appliance to a second configuration²⁴ in accordance with the at least a portion of the second configuration data²⁵, wherein: receiving at least the portion of the first configuration data includes: receiving first relay data responsive to an external network server identified in the first access data, and receiving at least a portion of the first configuration data made accessible via the network access by the first relay data²⁶; and receiving at least the portion of the second configuration data includes: receiving second relay data responsive to an external network server identified in the second access data, and receiving at least a portion of the second configuration data made accessible via the network access by the second relay data²⁷.

Independent claim 14, and dependent claims 15-17, are directed to a method of controlling an appliance, the method including: receiving, at the appliance, an address of an external relay server from a remote device²⁸, transmitting, from the appliance, a first request to the relay server²⁹, receiving, at the appliance, a profile address from the relay server, based on the first request³⁰, transmitting, from the appliance, a second request to an external profile server corresponding to the profile address³¹, receiving, at the appliance, user preference data from the profile server, based on the second request³², and controlling the appliance in accordance with the user preference data³³.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 5, 7, 9, 10, 12-21, and 24-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable for obviousness over U.S. Patent No. 6,139,177 to Venkatraman, et al. (hereinafter

²⁰ E.g., specification, ll. 4-15, page 5 and claims 6-9 as originally filed.

²¹ E.g., specification, ll. 7-20, page 5, ln. 21, page 5 – ln. 8, page 6, ll. 7-16, page 20, and claims 6-9 as originally filed.

²² E.g., specification, ll. 4-10, pg. 5, and ln. 16, page 20- ln. 2, page 21, and claims 6-9 as originally filed.

²³ E.g., specification, ll. 4-10, pg. 5, and ll. 2-11, page 21, and claims 6-9 as originally filed.

²⁴ E.g., specification, ll. 16-20, page 5, and claims 6-9 as originally filed.

²⁵ E.g., specification, ll. 12-20, pg. 5, and claims 6-9 as originally filed.

²⁶ E.g. specification, ln.12, page 20 - ln. 9, pg. 21, and claims 6-9 as originally filed.

²⁷ E.g. specification, ln.12, page 20 - ln. 9, pg. 21, and claims 6-9 as originally filed.

²⁸ E.g. specification, ll. 12-16, page 20, and FIG. 4.

²⁹ E.g. specification, ll. 16-21, page 20, and FIG. 4.

³⁰ E.g. specification, ll. 21-23, page 20, and FIG. 4.

³¹ E.g. specification, ln. 23, page 20 - ln. 2, page 21, and FIG. 4.

³² E.g. specification, ll. 2-3, page 21, and FIG. 4.

³³ E.g. specification, ll. 2-20, page 5, and claims 6-13 as originally filed.

“Venkatraman”) in view of U.S. Patent Application Publication No. 2001/0045451 to Tan et al. (hereinafter, “Tan”) and U.S. Patent No. 6,862,612 to Horn et al. (hereinafter, “Horn”)³⁴.

Claims 22 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable for obviousness over Venkatraman in view of Tan and Horn, and further in view of U.S. Patent No. 6,912,578 to Hanko, et al. (hereinafter, “Hanko”)³⁵.

Each of the foregoing rejections is appealed by Applicant.

ARGUMENT

I. INTRODUCTION TO THE INVENTION

Many modern appliances such as televisions, telephones, computers, etc. are capable of providing such a large array of options that a demand exists for devices that allow them to be personalized to make them easier to use. For example, a set top box may include an electronic program guide that may be personalized either actively (e.g., by specifying rules for selecting or filtering out programming) or passively (e.g., by allowing the set top box to extract rules from use over an extended period of time). Other examples of personalizable appliances include telephone speed dial directories (which may include information of interest to a specific user), and personal computers (which typically allow a large variety of personal settings to be established to customize the working environment).

A first drawback of many personalizable appliances is the inability to store multiple user profiles. Additionally, if a user utilizes a new or different appliance, personal data associated with another (e.g., previously used) appliance is generally not available for use on the new or different appliance.

A second drawback of many personalizable appliances is that multiple users of a single appliance may employ divergent or conflicting criteria in selecting features. Alternatively, multiple users may expand the number of options so much that the benefits of personalization are diminished as each group member (e.g., family member) makes personalized contributions to a television electronic program guide or speed dial list. In the example of an electronic program guide, one family member’s selection of documentaries, another member’s selection of sitcoms, and another member’s selection of sports programs may contribute to expansion of the selection space to something that is nearly as impersonal as an unpersonalized electronic program guide.

³⁴ See 04/01/09 Office Action, pp. 2-7.

³⁵ See 04/01/09 Office Action, pp. 7-8.

A conventionally employed method attempting to overcome some of the foregoing difficulties in the particular environment of an Internet terminal involves use of smart cards to store personal identification data. A smart card containing a unique network address may be inserted into a set top box. Information on the smart card is transmitted to an Internet server, and in response the server downloads to the set top box information particular to the user to configure the set top box. Information delivered by the server may include filtering information for viewing web sites, access privilege data in the form of a ticket, and favorites lists.

Conventional techniques address some difficulties in personalizing appliances, but fail to satisfactorily enable a user to easily personalize an appliance, to transfer information about preferences from one appliance to another, and to conveniently combine profiles of multiple users. Additionally, it would be preferable to implement personalization solutions without use of smart cards that may be fragile, expensive to replace, and require complex service infrastructure.

To overcome deficiencies of prior personalization solutions, various embodiments of the present invention relate to storage of user preferences or user profile data remotely from a user, and accessing stored user preferences or user profile data as needed. In at least one disclosed embodiment, a token (e.g., such as embodied in a radio frequency identification (RFID) device) contains a pointer to a relay location on a network with a further pointer indicating a profile location where user profile data is stored. When a user wants to use an appliance, the user places the token near an appliance, and the appliance accesses the data from the site indicated (pointed to) by the relay location. The relay location may be embodied in or accessed with a unique (Internet) Uniform Resource Locator (URL), with the relay location storing an address for a profile server (independent of the relay location) that is maintained by and/or for the user. The simple, robust, and low cost nature of a token (e.g., which may store only an address in read-only memory, in contrast to a smart card that contains detailed and updateable profile information in rewritable memory) renders it economical for a device manufacturer to supply one or more tokens with a new appliance. Since the relay location corresponds to the token only and provides a simple pointing function, it is also economical (e.g., for an appliance manufacturer) to maintain a relay server comprising the relay location. Segregation of the relay location and profile location also relieves the appliance manufacturer from the necessity of maintaining a profile server, which may optionally be hosted by another party and maintained by and/or for the user.

As noted previously, independent claim 5 and the claims depending therefrom are directed to an appliance including a controller and a receiver connected thereto, being effective to receive a

device identifier from a remote communications device; and a network interface connectable to an external relay server corresponding to the device identifier; the controller being configured to: [a] transmit data corresponding to the device identifier to the relay server, [b] receive a profile address in response from the relay server, [c] transmit a request to an external profile server at the profile address, [d] receive one or more user preferences from the profile server, and [e] control the appliance based on the one or more user preferences³⁶. Steps [a] to [d] are consistent with the foregoing description of a relay server that is used to store a profile address, with the profile address being used to store one or more user preferences that are accessed and used to control an appliance.

Independent claim 9 and the claims depending therefrom are directed to a method of controlling the operation of an appliance, including: [a][1] receiving, at the appliance, first access data from memory of a first remote device, the first access data providing network access to first configuration data corresponding to a first set of user preferences on an external network; receiving at the appliance at least a portion of the first configuration data via the network access; [a][2] configuring the appliance to a first configuration in accordance with at least a portion of the first configuration data; [b][1] receiving, at the appliance, second access data to the appliance from a memory of a second remote device, the second access data providing network access to second configuration data corresponding to a second set of user preferences on the external network; receiving at the appliance at least a portion of the second configuration data via the network access; and [b][2] reconfiguring the appliance to a second configuration in accordance with the at least a portion of the second configuration data, wherein: [a][3] receiving at least the portion of the first configuration data includes: receiving first relay data responsive to an external network server identified in the first access data, and receiving at least a portion of the first configuration data made accessible via the network access by the first relay data; and [b][3] receiving at least the portion of the second configuration data includes: receiving second relay data responsive to an external network server identified in the second access data, and receiving at least a portion of the second configuration data made accessible via the network access by the second relay data³⁷. Steps [a][1] to [a][3] relate to a first configuration of the appliance using first configuration data, consistent with the foregoing description of aspects of Applicant's invention. Steps [b][1] to [b][3] relate to reconfiguration of the appliance using second configuration data, consistent with the foregoing description of aspects of Applicant's invention. Such configuration and reconfiguration steps are

³⁶ Such claim has been annotated to include identifiers [a] to [e] to promote clarity.

³⁷ Such claim has been annotated to include identifiers [a][1] to [a][3] and [b][1] to [b][3] to emphasize relationships between related subject matter.

useful, for example, to personalize configuration of an appliance for a first user, and thereafter to personalize configuration of the same appliance for a second user.

Independent claim 14 and the claims depending therefrom are directed to a method of controlling an appliance, the method including: [a] receiving, at the appliance, an address of an external relay server from a remote device; [b] transmitting, from the appliance, a first request to the relay server; [c] receiving, at the appliance, a profile address from the relay server, based on the first request; [d] transmitting, from the appliance, a second request to an external profile server corresponding to the profile address; [e] receiving, at the appliance, user preference data from the profile server, based on the second request; and [f] controlling the appliance in accordance with the user preference data³⁸. Steps [a] to [e] are consistent with the foregoing description of a relay server that is used to store a profile address, with the profile address being used to store one or more user preferences that are accessed and used to control an appliance.

II. NONE OF CLAIMS 14-17 ARE OBVIOUS UNDER 35 U.S.C. 103 OVER VENKATRAMAN IN VIEW OF TAN AND HORN

A. Neither Tan Nor Horn Are Properly Combinable With Venkatraman Against Independent Claim 14 and Dependent Claims 15-17 under 35 U.S.C. § 103(a)

An obviousness rejection must be premised on art reasonably available to the applicant. “In order to rely on a reference as a basis for rejection of an applicant's invention, the **reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem** with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992); *see also In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); MPEP 2141.01(a)³⁹.” The proposed combination of Tan and Horn with Venkatraman is not supportable, since neither Tan nor Horn are in the same field as applicant's endeavor, or are pertinent to the problem addressed by the subject matter of Applicant's claims.

³⁸ Such claim has been annotated to include identifiers [a] to [f] to promote clarity.

³⁹ More recently, the Supreme Court stated that “[w]hen a work is available in one field, design incentives and other market forces can prompt variations of it, either in the same field or in another.” *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385, 1389 (2007). The issue of combinability or applicability of art (e.g., under MPEP 2141.01(a)) was not squarely before the Supreme Court in *KSR*, however, since all of the art at issue was drawn from the field of the applicant's endeavor (namely, automotive throttle pedals). Here, the examiner has failed to identify any “design incentive or other market forces” that would prompt a combination of Tan and/or Horn with Venkatraman to yield the subject matter of Applicant's claims, let alone satisfy the established test for combinability or applicability of references set forth in MPEP 2141.01(a).

Venkatraman discloses devices (e.g., including office equipment, home-based equipment, and lab equipment⁴⁰) having embedded web access to provide device access and control functionality. Such devices include control and access mechanism that are simple, and typically constructed to be low cost to minimize the overall cost of such devices. Enhanced control and access functions that could be implemented with display screens and graphical user interface software would entail “[s]uch high costs [to be] typically unsuitable for lower cost devices targeted for a relative large mass market⁴¹.” To provide enhanced access and control capability to such devices, Venkatraman discloses devices having embedded web functionality. “[A] web core 14 enables access to the device home page 18 which is a web page that enables a user to access and control the device 10 using an external web browser. The device home page 18 enables a user of an external web browser to examine and control any software objects installed in the device 10 and to control device-specific functions of the device 10 and to access other information associated with the device⁴².”

Neither Tan nor Horn are properly combinable with Venkatraman, as neither Tan nor Horn are in the field of control of appliances, or are reasonably pertinent to the particular problem of enabling user profiles or personal settings to be easily applied to different appliances or easily re-set for different users. Tan relates to a system for token-based user access authentication to enable secure user access to a web server using a token, such as a smart card, and provides a single sign-on mechanism that does not employ a user name and password in the log-on process⁴³. Tan specifically focuses on online financial transactions including online commercial use of credit cards and online banking⁴⁴. Horn relates to the saving at a central location of one or more sets of purchaser-specific information, and retrieval and user of such information by multiple server systems⁴⁵. Like Tan, Horn is specifically concerned with online commercial transactions. As neither Tan nor Horn are in the field of control of appliances, or are reasonably pertinent to the particular problem of enabling user profiles or personal settings to be easily applied to different appliances or easily re-set for different users, neither Tan nor Horn is properly combinable with Venkatraman against Applicant’s claim 14

⁴⁰ See Venkatraman, col. 1, ll. 25-35: “Office equipment includes, for example, printers, fax machines, copiers, and various types of communication and telephony devices. Home-based devices include home entertainment equipment such as televisions and video and audio players and recorders as well as security systems, automobiles, appliances, thermostats, and hot tubs. Lab equipment includes measurement devices such as oscilloscopes, spectrum analyzers and other types of measurement equipment as well as networking equipment.”

⁴¹ Venkatraman, col. 1, ll. 54-57.

⁴² Venkatraman, col. 3, ll. 20-27.

⁴³ See Tan, Abstract, and ¶ 6-11, pg. 1.

⁴⁴ See Tan, ¶ 28-29, page 3, and ¶ 30-38, page 4.

⁴⁵ See Horn, Abstract and ln. 61, col. 3 – ln. 21, col. 4.

and dependent claims 15-17⁴⁶. Such fact provides a basis for withdrawing the claim rejection to claim 14 and dependent claims 15-17 that is *independent* of the failure of any hypothetical combination of these references to disclose all elements of Applicant's claims.

Accordingly, reversal of the rejection of claim 14 and dependent claims 15-17 based on the combination of Venkatraman, Tan, and Horn is warranted, and is respectfully requested.

B. The Examiner Has Failed to Provide Articulated Reasoning With Some Rational Underpinning to Support the Legal Conclusion of Obviousness of Independent Claim 14 and Dependent Claims 15-17

Applicant's pending claims include three independent claims - namely, appliance claim 5, method claim 9, and method claim 14. Of these three independent claims 5, 9, and 14, the April 1, 2009 Final Office Action provides a detailed rejection of independent claim 14 only. In other words, no detailed rejection of independent claims 5 and 9 is contained in the April 1, 2009 Office Action. In accordance with Appeal practice⁴⁷, detailed arguments regarding the examiner's failure to provide properly detailed rejections of independent claims 5 and 9 and the claims depending therefrom is provided in sections III and IV, *infra*.

As compared to claims 5 and 14, the April 1, 2009 Final Office Action does contain certain details supporting the rejection of independent claim 14. The rejection of claim 14, however, still lacks sufficient "articulated reasoning with some rational underpinning" to properly support a rejection under 35 U.S.C. § 103, as detailed below.

In *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007), the Supreme Court stated that:

"A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. ... [Rather], it can be **important to identify a reason that would have prompted a person of ordinary skill in the relevant art to combine the [prior art] elements in the manner claimed.**"⁴⁸,

⁴⁶ See Claim 14 and claims 15-17.

⁴⁷ See MPEP 1205.02 (*Appeal Brief Content*) and *In re McDaniel*, 293 F.3d 1379, 1384, 63 USPQ2d 1462, 1465-66 (Fed. Cir. 2002).

⁴⁸ See *KSR*, 82 USPQ2d at 1389 (emphasis added).

It is fundamental to a proper rejection of claims under 35 U.S.C. § 103 that an examiner must present a convincing line of reasoning supporting the rejection⁴⁹. The Supreme Court in *KSR* affirmed the validity of such approach, stating that “**there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness**”⁵⁰.”

At page 4 of the April 1, 2009 Office Action, the examiner justified the hypothetical combination of Venkatraman with Tan and Horn as follows:

“It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Venkatraman et al with Tan et al and Horn et al **for the purpose of equipping a smartcard with web server access abilities**, in order to invoke communicate [sic – *communication of*] data from the smartcard to a particular server for user authentication or for secure access to a specific website. Furthermore, accessing customer/user profiles maintained in an external/remote server is obvious and well-known in the art for the purpose of offloading the maintenance of customer/user profiles to a dedicated server, and accessing the dedicated profile server to obtain control [of] a customer/user device based on preferences of and data related to the customer/user.” (Emphasis added.)

A first problem with the foregoing argument stated in the Office Action is that Applicant’s claims do not recite any smart card. Indeed, the background section of the present application specifically describes the need to overcome difficulties in adapting appliance without having to support complex service infrastructures such as required by smart card systems⁵¹.” Given the lack of presence of any smart card in Applicant’s claims, and the teaching in the present application to avoid use of smart cards, the reasoning advanced by the examiner to support combination of Venkatraman with Tan and Horn lacks any rational underpinning the conclusion of obviousness, as required by *KSR, supra*, to support the conclusion of obviousness.

Another problem with the foregoing argument stated in the Office Action is that Venkatraman does not disclose or relate to use of any smart card. Instead, Venkatraman discloses use of an external web browser to control device-specific functions of a device and to access information associated with the device⁵². Venkatraman discloses that such a web browser may be embodied in a computer system that executes web browser software, or in other devices that provide HTTP [hyper text transfer protocol] client functions and that render HTML [hypertext markup language] files, such as specialized television of telephone network devices, low cost web browser

⁴⁹ See MPEP 2144 (“*Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103*”), citing *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985).

⁵⁰ See *KSR*, 82 USPQ2d at 1396 (emphasis added).

⁵¹ Specification, pg. 4, ll. 18-21.

⁵² Venkatraman, col. 3, ll. 20-27.

devices, and network computers⁵³. Nothing in Venkatraman discloses or remotely suggests any smart card, which would require presence of a smart card reader and also limit web access to users having smart cards. Addition of a smart card to Venkatraman's web-enabled device control system would require substantial reconstruction or redesign, or a change in basic operating principles of Venkatraman's system. It is well-established that a suggestion to combine references **cannot require substantial reconstruction or redesign** of such references, **or a change in basic operating principles** of a construction of a reference, to arrive at the claimed invention⁵⁴.

At page 2 of the July 17, 2009 Advisory Action, the examiner stated that:

"Venkatraman's invention of a system for device access and control using embedded web access functionality is implemented on devices that are operable with smart cards such as 'communication and telephony devices, home entertainment devices and, such as television, video and audio devices...[and] computer peripheral devices including mass storage units.' (col.4 lines 21-25) [citing Venkatraman]. Thus using smart cards is not far reaching or destructive to Venkatraman's system for device access and control using embedded web access functionality..."

Appellant respectfully disagrees with the examiner's conclusion. Merely because devices are disclosed by Venkatraman that *could be operated* in conjunction with a smart card is not dispositive of whether Venkatraman's system would require substantial reconstruction or redesign, or a change in basic operating principles to be implemented with a smart card, as Appellant contends. Moreover, Venkatraman specifically teaches away from providing enhanced control and access functions with expensive solutions (e.g., display screens and graphical user interface software) that entail "[s]uch high costs [to be] typically unsuitable for lower cost devices targeted for a relative large mass market⁵⁵." Utilization of smart cards in devices according to Venkatraman would require expensive smart card communication hardware to be integrated into such devices, thus contravening Venkatraman's avowed purpose of ensuring that enhanced control and access capabilities remain suitable for lower cost devices targeted for a large mass market.

Additionally, Applicant respectfully disagrees with the examiner's allegation that "accessing customer/user profiles maintained in an external/remote server is obvious and well-known in the art for the purpose of ... accessing the dedicated profile server to obtain control [of] a customer/user device based on preferences of and data related to the customer/user⁵⁶." This is an unsupported conclusion lacking articulated reasoning with some rational underpinning, the likes of which have

⁵³ Venkatraman, col. 5, ll. 3-15.

⁵⁴ *In re Ratti*, 270 F.2d 810, 123 USPQ 349, 352 (C.C.P.A. 1959).

⁵⁵ Venkatraman, col. 1, ll. 54-57.

⁵⁶ See April 1, 2009 Final Office Action.

been deemed insufficient for supporting an obviousness rejection⁵⁷. If such purported fact is indeed well known in the art as alleged by the examiner, then the examiner should present competent evidence of same, or withdraw the allegation and rejection premised upon same, as Applicant argued in the Response to the April 1, 2009 Final Office Action.⁵⁸

In the July 14, 2009 Advisory Action, the examiner reiterated the foregoing allegation without providing supporting evidence – again advancing an unsupported conclusion regarding the state of the art without providing evidence supporting same⁵⁹.

Since dependent claims inherently include all the features of the claims on which they depend⁶⁰, the foregoing arguments relating to claim 14 apply equally to claims 15-17 depending therefrom.

Based on the foregoing, reversal of the rejections of independent claim 14 and dependent claims 15-17 is warranted, and is respectfully requested.

C. The Cited Art Fails to Disclose All Elements of Applicant's Independent Claim 14 and Dependent Claims 15-17

Applicant's claim 14 is directed to a method of controlling an appliance, including steps involving the appliance as well as a remote device⁶¹, an external relay server⁶², and an external profile server⁶³. A graphic summarizing communications between these elements as pertinent to Applicant's claim 14 was provided in the Amendment filed on January 9, 2009 and in the Amendment filed on May 29, 2009; such graphic is further reproduced below.

⁵⁷ See *KSR, supra*.

⁵⁸ See May 29, 2009 Response to Final Office Action.

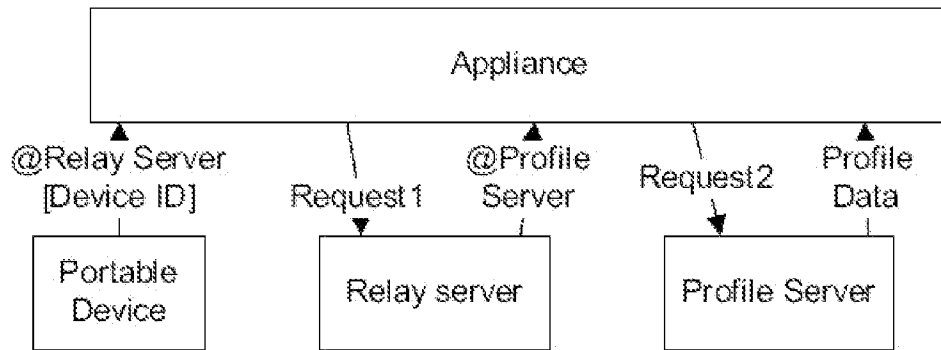
⁵⁹ See July 14, 2009 Advisory Action, page 2.

⁶⁰ 35 U.S.C. 112, fourth paragraph.

⁶¹ According to claim 14, the appliance receives an address of an external relay server from the remote device.

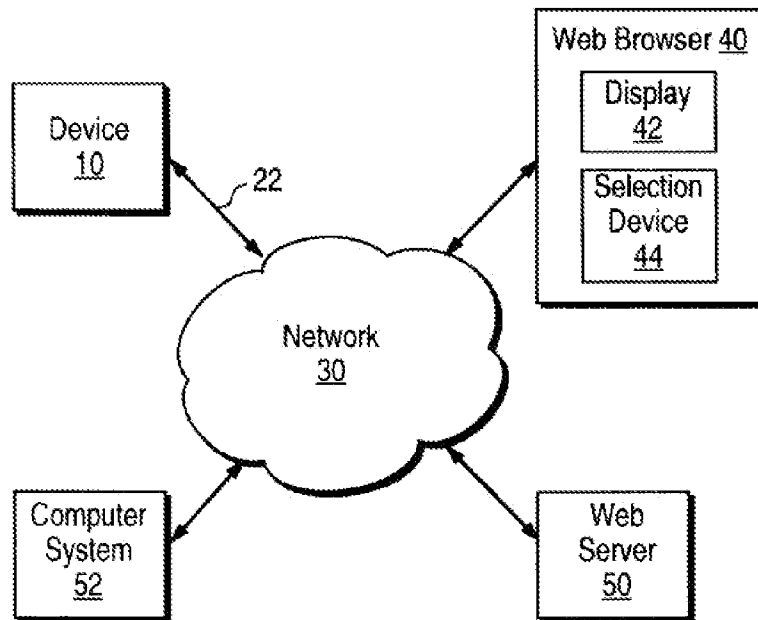
⁶² According to claim 14, the external relay server receives transmission of a first request from the appliance, and the appliance receives a profile address from the relay server.

⁶³ According to claim 14, the appliance receives user preference data from the external profile server based on transmission of a second request transmitted from the appliance.



In connection with Venkatraman Figure 2 (reproduced below), Venkatraman discloses a device 10 that may be remotely accessed and controlled with a web browser 40 via an interposing network 30, and discloses a web server 50 that is provided for the specific purpose of providing (for download to the device 10) “package files, software elements, and software updates⁶⁴.”

FIG. 2



At col. 3, lines 1-10 thereof, Venkatraman states:

⁶⁴ See Venkatraman, col. 4, ll. 43-51.

HTTP commands are used by web clients to obtain information from the device 10 including the device home page 18, the loader web page 28, and the registered interest web page 29. In addition, **HTTP commands are generated in the device 10** to perform file transfers via the communication link 22 and to obtain new information and software elements for loading into the device 10 and for updating native code in the device 10⁶⁵.

The loading aspect mentioned above is further detailed in the following passage⁶⁶ of Venkatraman, which discusses the loading function as involving the web server 50 to provide a package file that embodies text listing URLs of one or more components to be loaded or installed to the device 10 for purposes of software updating or installation:

FIG. 5 of Venkatraman illustrates the handling of a load request by the loader 24.

* * *

If the security check passes at step 160, then at step 162 the loader 24 downloads the package file specified by the URL contained in the load request. The loader 24 uses file transfer services provided by the web core 14 to perform the file transfer of the package file via the network 30. The package file may be store anywhere on the network 30. For example, the **package file may be stored on the web server 50** or the computer system 52.

The package file in one embodiment is a **text file that lists URLs of one or more components to be loaded or installed** and further specifies a type indication for each component. The type indication specifies whether the corresponding component is part of a new software object to be loaded into the device 10 or part of native code to be installed into the device 10.

The only disclosed functions of Venkatraman's web server 50 are to provide the foregoing software elements, software updates, and package files identifying addresses of one or more software components to be loaded or installed.

Venkatraman fails to disclose an external profile server that contains user preference data, let alone the reception and transmission steps involving the external profile server as recited in Applicant's claim 14. Likewise, Venkatraman fails to disclose an external relay server that contains an address for an external profile server that contains user preference data, let alone the reception and transmission steps involving the external relay server as recited in Applicant's claim 14.

Venkatraman's web browser 40 is provided to "access[] and control the device 10 via the network 30 by accessing the device home page 18, the loader web page 28, and the register interest

⁶⁵ See Venkatraman, col. 3, lines 1-10, (emphasis added).

⁶⁶ See Venkatraman, col. 7, lines 35-59 (emphasis added).

web page 29 using HTTP protocols⁶⁷.” Such access and control functions of Venkatraman’s web browser 40 cannot be equated with the functions of *storing and supplying user preference data* as provided by Applicant’s external profile server, or the functions of *storing and supplying profile server address information* as provided by Applicant’s external relay server.

As discussed previously, Venkatraman’s web server 50 provides software elements, software updates, and package files identifying addresses of one or more software components to be loaded or installed. The software storage and/or software address storage functions of Venkatraman’s web server 50 cannot be equated with the functions of *storing and supplying user preference data* as provided by Applicant’s external profile server, or the functions of *storing and supplying profile server address information* as provided by Applicant’s external relay server.

Thus, neither Venkatraman’s web browser 40 nor Venkatraman’s web server 50 embody a “relay server” or a “profile server” as recited in Applicant’s claim 14.

At pages 2-3 of the April 1, 2009 Office Action, the examiner alleges that Venkatraman discloses various (but not all) elements of claim 14, and identifies alleged support for such elements. Such allegations of the examiner are summarized below, together with Applicant’s comments regarding same.

⁶⁷ See Venkatraman, col. 4, ll. 43-48 and col. 3, ll. 20-30.

| <u>Claim Element</u> | <u>Examiner's Identification of Alleged Support for Claim Element in Venkatraman</u> | <u>Applicant's Comments</u> |
|--|---|---|
| "Transmitting from the appliance, a first request to the relay server" | "Col. 5 lines 36-67 – transmits first request to the device's web server." | <p>Col. 5, lines 36-67 of Venkatraman refers to user access of a device home page of the device 10 using a web browser 40, wherein "[t]he user enters a URL corresponding to the device home page 18 into the web browser 40⁶⁸," and the device responsively returns the device home page 18 to the web browser⁶⁹" The web core 14 of the device 10 either "generates the device home page 18 on the fly," or stores in memory of the device in HTML format "contents of the device home page [that] are periodically updated by web core 14⁷⁰"</p> <p>The foregoing passages of Venkatraman disclose direct communication between the device 10 and the web browser 40 initiated by entry of address information by a user, <u>without need for any "relay server" to facilitate storage and communication of address information.</u> Venkatraman does not disclose any relay server.</p> |

⁶⁸ Venkatraman, col. 5, lines 36-38.

⁶⁹ Venkatraman, col. 5, lines 43-45.

⁷⁰ Venkatraman, col. 5, lines 46-62.

| <u>Claim Element</u> | <u>Examiner's Identification of Alleged Support for Claim Element in Venkatraman</u> | <u>Applicant's Comments</u> |
|--|--|---|
| "Receiving, at the appliance, a profile address from the relay server, based on the first request" | "Col. 6, line 5 – col. 7, line 8 – receiving address of the loader web page from the device's homepage." | <p>Venkatraman states the following at col. 6, lines 53-64:</p> <p>"A user accesses the loader 24 in the device 10 by selecting the hyperlink 66 using the web browser 40. In response, the web browser 40 obtains the URL for the loader 24 from the device home page 18 stored in the web browser 40 and transfers an HTTP command which includes the URL for the loader 24 over the network 30. The web core 14 receives the HTTP command via the communication path 22 and recognizes the URL for the loader 24 contained therein. The web core 14 passes the received HTTP command to the loader 24. The loader 24 then provides the loader web page 28 to the web core 14 which transfers the loader web page 28 to the web browser 40 over the network 30."</p> <p>Venkatraman's loader 24 and web core 14 are within the device 10 (see Venkatraman FIG. 1); the web core 14 and may be used to load or install software components⁷¹. As noted in the foregoing excerpt, the web core 14 (in the device 10) receive a HTTP command from the web browser, which command contains the URL for the loader (in the device 10), and ultimately causes the web core 14 to transfer the loader web page to the web browser 40.</p> <p>The only address received by the device 10 is the URL for the loader 24 – which is <i>part of the</i> device 10. There is no indication in Venkatraman that the loader 24 embodies a "profile address" as recited in Applicant's claim 14. Moreover, Venkatraman fails to disclose any relay server as recited in claim 14.</p> |

⁷¹ Venkatraman, col. 7, ln. 53 – col. 8, ln. 9.

| <u>Claim Element</u> | <u>Examiner's Identification of Alleged Support for Claim Element in Venkatraman</u> | <u>Applicant's Comments</u> |
|---|--|---|
| "Transmitting, from the appliance, a second request to a profile server corresponding to the profile address" | "Col. 3 lines 39-53, col. 7 lines 9-52 – transmit load request to loader webpage via an external web browser, hence the loader webpage is provided by external source/server accessible via the external browser of the web core." | As noted immediately above, Venkatraman's web browser 40 obtains the URL for the loader 24 from the device home page 18 stored in the web browser 40 – and such home page 18 is generated by or at least updated by the web core 14 within the device 10. There is no indication in Venkatraman that the loader 24 embodies a "profile address" as recited in Applicant's claim 14. Moreover, Venkatraman fails to disclose any profile server. |
| "Receiving, at the appliance, data from the profile server, based on the second request" | "Col. 3, lines 38-53, col. 7, line 53 - col. 8, line 9 – receive updated device configuration from loader after downloading components from a retrieved package file." | As noted previously, Venkatraman fails to disclose any profile server. |
| "Controlling the appliance in accordance with the data from the profile server" | "Abstract, col. 3, lines 20-30 & 38-58, col. 8, lines 5-9 – controlling and configuring the appliance based upon the downloaded components from the loader." | As noted previously, Venkatraman fails to disclose any profile server. |

The April 1, 2009 Office Action at page 3 thereof expressly concedes that Venkatraman "fail[s] to explicitly teach[:]"

[A] receiving, at the appliance, an address of an external relay server from a remote device, and

[B] receiving at the appliance, user preference data from the external profile server and controlling the appliance in accordance with the user preference data."

In seeking to remedy the failure of Venkatraman to disclose the foregoing elements [A] and [B], the Office Action points to the disclosures of Tan and Horn.

Tan has been cited by the examiner as disclosing “receiving the address of an external access/web server from a smart card ... upon which the access server generates an authentication cookie that allows the user’s browser access to additional servers on behalf of the user⁷².” Tan’s authentication cookie is communicated to the browser of the client workstation⁷³; however, such cookie does not constitute “user preference data” as recited in claim 14. Tan fails to disclose an external relay server that contains an address for an external profile server that contains user preference data that may be used for control of an appliance. Tan also fails to disclose reception by the appliance of a profile address, followed by transmission from the appliance of a request to an external profile server, and reception at the appliance of user preference data useful for controlling the appliance.

Horn has been cited by the examiner as disclosing “retrieving customer profile information from the unique location of a remote customer data bank or application server that stores customers profile information and using the retrieved profile to operate the device according to the customer’s preferential data⁷⁴.” Although Horn does store customer profile information in a server, Horn fails to disclose use of any external relay server that contains an address for an external profile server that contains user preference data that may be used for control of an appliance. Horn also fails to disclose reception by the appliance of a profile address, followed by transmission from the appliance of a request to an external profile server, and reception at the appliance of user preference data useful for controlling the appliance.

Based on the foregoing, none of Venkatraman, Tan, or Horn, whether alone or in combination⁷⁵, disclose all features of claim 14. Accordingly, reversal of the rejection of claim 14 is warranted, and is respectfully requested. Because dependent claims inherently include all of the features of the claims on which they depend⁷⁶, all claims depending from claim 14 are likewise distinguished over Venkatraman, Tan, and Horn, such that reversal of the rejections of such dependent claims is warranted, and is respectfully requested.

III. NONE OF CLAIMS 5, 18, 19, AND 20 ARE OBVIOUS UNDER 35 U.S.C. 103 OVER VENKATRAMAN IN VIEW OF TAN AND HORN

⁷² See April 1, 2009 Office Action, page 3.

⁷³ See Tan, ¶ [0013]

⁷⁴ See April 1, 2009 Office Action, page 3.

⁷⁵ Applicant hereby does not concede that Venkatraman is properly combinable with either Tan or Horn.

⁷⁶ 35 U.S.C. 112, fourth paragraph.

A. Neither Tan Nor Horn Are Properly Combinable With Venkatraman Against Independent Claim 5 and Dependent Claims 18-20 under 35 U.S.C. § 103(a)

As stated previously herein, “[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned⁷⁷.” Neither Tan nor Horn are properly combinable with Venkatraman, as neither Tan nor Horn are in the field of control of appliances, or are reasonably pertinent to the particular problem of enabling user profiles or personal settings to be easily applied to different appliances or easily re-set for different users. The arguments stated previously herein regarding the same issue (i.e., in connection with claims 15-17) are hereby incorporated by reference as to claims 5 and 18-20.

Since Applicant’s claim 5 and dependent claims 18-20 relate to an appliance, including, *inter alia*, a controller arranged to receive a device identifier from a remote communications device, with the controller being configured to communicate with an external relay server and an external profile server, and control the appliance based on one or more user preferences received from the profile server⁷⁸, the lack of combinability between either Tan or Horn and Venkatraman provides a first basis for withdrawing the rejections of claims 5 and 18-20 under 35 U.S.C. 103. Such basis is *independent* of the failure of any hypothetical combination of these references to disclose all elements of Applicant’s claims.

Accordingly, reversal of the rejections of claims 5 and 18-20 under 35 U.S.C. 103 premised on the combination of Venkatraman, Tan, and Horn is warranted, and is respectfully requested.

B. The Examiner Has Failed to Provide Articulated Reasoning With Some Rational Underpinning to Support the Legal Conclusion of Obviousness of Independent Claim 5 and Dependent Claims 18-20 under 35 U.S.C. § 103(a)

As stated previously herein, the April 1, 2009 Office Action failed to provide any detailed rejections of independent claims 5 and 9, and the claims depending therefrom. Independent claims 5 and 9 include limitations that are markedly different from claim 14, but in each instance the examiner merely stated that each such claim “contains limitations that are similar to [another claim],

⁷⁷ See *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992); see also *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); MPEP 2141.01(a).

⁷⁸ See claim 5 and claims 18-20.

and is therefore rejected under the same basis.”⁷⁹ In the July 14, 2009 Advisory Action, the examiner reiterated this position with respect to claims 5 and 9, stating that “[c]laim 14 is more detailed than claims 5 and 9 therefore the reasoning used for rejecting the limitations of claim 14 can also be extended to the broad limitations of claims 5 and 9.”

Applicant respectfully disagrees with the examiner’s suggestion that detailed rejections are not required with respect to claims 5 and 9. Claim 5 is a claim directed to an apparatus (namely, an appliance), which belongs to a completely different statutory class than the methods embodied in claims 9 and 14⁸⁰. Additionally, claim 5 relates to an appliance that includes, *inter alia*, a controller, a receiver, and a network interface, with the controller being configured to perform several enumerated steps. Claim 14 fails to recite any controller whatsoever, such that the one or more steps recited therein may be performed by different or other components. Moreover, claim 14 requires “transmitting, from the appliance, a first request to the relay server,” whereas claim 5 requires that the controller is “configured to[] transmit data corresponding to the device identifier to the relay server.” Transmission of “data corresponding to the device identifier” may embody different scope than transmission of “a first request.” The examiner has failed to point to any disclosure in the cited art of a controller is “configured to[] transmit data corresponding to the device identifier to the relay server” as required by claim 5. Given at least the foregoing differences between claim 5 and claim 14, detailed consideration of claim 5 separate from claim 14 is warranted, since the rejection of claim 14 does not establish the presence of all elements of claim 5 in the cited art.

Moreover, the reasoning advanced by the examiner to combine the teachings of Venkatraman with Tan and Horn – namely, “for the purpose of equipping a smartcard with web server access abilities⁸¹” – is inapposite to Applicant’s claim 5, since such claim fails to recite any smart card. Indeed, the background section of the present application specifically describes the need to overcome difficulties in adapting appliance without having to support complex service infrastructures such as required by smart card systems⁸². Given the lack of presence of any smart card in Applicant’s claims, and the teaching in the present application to avoid use of smart cards, the reasoning advanced by the examiner to support combination of Venkatraman with Tan and Horn lacks any rational underpinning the conclusion of obviousness, as required by *KSR, supra*, to support the conclusion of obviousness.

⁷⁹ See April 1, 2009 Office Action, page 5.

⁸⁰ See claims 5, 9, and 14.

⁸¹ See April 1, 2009 Office Action, page 4.

⁸² Specification, pg. 4, ll. 18-21.

Accordingly, because the rejection of claim 5 is not supported by any comparison to the cited art or related reasoning, the rejection of claim 5 is improper and should be reversed⁸³. Since dependent claims inherently include all the features of the claims on which they depend, the rejections of claims 18-20 should be reversed for at least the same reasons as articulated in connection with claim 5.

C. The Cited Art Fails to Disclose All Elements of Applicant's Claims 5 and 18-20

Applicant's independent claim 5 relates to an appliance, including, *inter alia*, a controller and receiver effective to receive a device identifier from a remote communications device, with the controller being configured to communicate with an external relay server and an external profile server, and configured to control the appliance based on one or more user preferences received from the profile server.

Despite differences between independent claims 5 and 14, the April 1, 2009 Office Action included a summarial rejection of claim 5 on the following basis:

"Claim 5 differs in statutory class, yet contains limitations that are substantially equivalent to [independent] claim 14 and is therefore rejected under the same basis"⁸⁴.

It has been previously established herein (i.e., in connection with claim 14) that Venkatraman fails to disclose in combination a relay server and a profile server, let alone specific reception and transmission steps involving a relay server and a profile server.

Venkatraman's web browser 40 is provided to "access[] and control the device 10 via the network 30 by accessing the device home page 18, the loader web page 28, and the register interest web page 29 using HTTP protocols⁸⁵." Such access and control functions of Venkatraman's web browser 40 cannot be equated with the functions of *storing and supplying user preference data* as provided by Applicant's external profile server, or the functions of *storing and supplying profile server address information* as provided by Applicant's external relay server.

As discussed previously, Venkatraman's web server 50 provides software elements, software updates, and package files identifying addresses of one or more software components to be loaded or

⁸³ See MPEP 2144 ("Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103"), citing *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985); *KSR International Co. v. Teleflex Inc.*, 127 S.Ct 1727, 167 L.Ed.2d 705, 82 USPQ2d 1385 (April 30, 2007).

⁸⁴ See April 1, 2009 Office Action, page 4.

⁸⁵ See Venkatraman, col. 4, ll. 43-48 and col. 3, ll. 20-30.

installed. The software storage and/or software address storage functions of Venkatraman's web server 50 cannot be equated with the functions of *storing and supplying user preference data* as provided by Applicant's external profile server, or the functions of *storing and supplying profile server address information* as provided by Applicant's external relay server.

Although Venkatraman's web browser and web server provide certain access and addressing functionality, the scope of Venkatraman is limited to providing access to a device via a device home page, not to providing the functions embodied in Applicant's claim 5.

It has also been previously established herein that Tan fails to disclose (1) an external relay server that contains an address for an external profile server that contains user preference data that may be used for control of an appliance, and (2) reception by the appliance of a profile address, followed by transmission from the appliance of a request to an external profile server, and reception at the appliance of user preference data useful for controlling the appliance.

It has been further established herein that Horn fails to disclose (1) use of any external relay server that contains an address for an external profile server that contains user preference data that may be used for control of an appliance, and (2) reception by the appliance of a profile address, followed by transmission from the appliance of a request to an external profile server, and reception at the appliance of user preference data useful for controlling the appliance.

Based on the foregoing, none of Venkatraman, Tan, or Horn, whether alone or in combination⁸⁶, disclose all features of claim 5. Accordingly, withdrawal of the rejection of claim 5 is warranted, and is respectfully requested. Because dependent claims inherently include all of the features of the claims on which they depend⁸⁷, all claims depending from claim 5 are likewise distinguished over Venkatraman, Tan, and Horn, such that reversal of the rejections of dependent claims 18-20 is warranted, and is respectfully requested.

IV. NONE OF CLAIMS 9, 7, 10, 12-13, 21, AND 24-25 ARE OBVIOUS UNDER 35 U.S.C. 103 OVER VENKATRAMAN IN VIEW OF TAN AND HORN

A. Neither Tan Nor Horn Are Properly Combinable With Venkatraman Against Independent Claim 9 and Dependent Claims 7, 10, 12-13, 21, 24-25 under 35 U.S.C. § 103(a)

⁸⁶ Applicant hereby does not concede that Venkatraman is properly combinable with either Tan or Horn.

⁸⁷ 35 U.S.C. 112, fourth paragraph.

As stated previously herein, [i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned⁸⁸." Neither Tan nor Horn are properly combinable with Venkatraman, as neither Tan nor Horn are in the field of control of appliances, or are reasonably pertinent to the particular problem of enabling user profiles or personal settings to be easily applied to different appliances or easily re-set for different users. The arguments stated previously herein regarding the same issue (i.e., in connection with claims 15-17) are hereby incorporated by reference as to independent claim 9 and claims 7, 10, 12, 12, 21, 24 and 25 depending therefrom.

Since Applicant's claim 9 and dependent claims 7, 10, 12-13, 21, 24-25 relate to a method of controlling the operation of an appliance and include, *inter alia*, receiving, at the appliance, first access data from memory of a first remote device, the first access data providing network access to first configuration data corresponding to a first set of user preferences on an external network; receiving at the appliance at least a portion of the first configuration data via the network access, and configuring the appliance to a first configuration in accordance with the at least a portion of the first configuration data; wherein receiving the at least the portion of the first configuration data includes: receiving first relay data responsive to an external network server identified in the first access data, and receiving the at least a portion of the first configuration data made accessible via the network access by the first relay data⁸⁹, the lack of combinability between either Tan or Horn and Venkatraman provides a first basis for withdrawing the rejections of claims 7, 10, 12-13, 21, 24-25 under 35 U.S.C. 103. Such basis is *independent* of the failure of any hypothetical combination of these references to disclose all elements of Applicant's claims..

Accordingly, reversal of the rejection of claim 9 and dependent claims 7, 10, 12-13, 21, 24-25 premised on the combination of Venkatraman, Tan, and Horn is warranted, and is respectfully requested.

B. The Examiner Has Failed to Provide Articulated Reasoning With Some Rational Underpinning to Support the Legal Conclusion of Obviousness of Independent Claim 9 and Dependent Claims 7, 10, 12-13, 21, 24-25

As stated previously herein, the April 1, 2009 Office Action failed to provide any detailed rejection of independent claims 5 and 9, and the claims depending therefrom. Independent claims 5

⁸⁸ See *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992); see also *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); MPEP 2141.01(a).

⁸⁹ See independent claim 9, and dependent claims 7, 10, 12-13, 21, 24-25.

and 9 include limitations that are markedly different from claim 14, but in each instance the examiner merely stated that each such claim “contains limitations that are similar to [another claim], and is therefore rejected under the same basis.”⁹⁰ In the July 14, 2009 Advisory Action, the examiner reiterated this position with respect to claims 5 and 9, stating that “[c]laim 14 is more detailed than claims 5 and 9 therefore the reasoning used for rejecting the limitations of claim 14 can also be extended to the broad limitations of claims 5 and 9.”

Applicant respectfully disagrees with the examiner’s suggestion that detailed rejections are not required with respect to claims 5 and 9. With respect to independent claim 9, such claim includes features that differ from those recited in independent claim 14. Claim 9 specifically requires “configuring the appliance to a first configuration” according to (at least a portion of) first configuration data, and “reconfiguring the appliance to a second configuration” according to (at least a portion of) second configuration data. No reconfiguration at all is recited in claim 14. Moreover, claim 14 requires “transmitting, from the appliance, a first request to the relay server,” whereas no transmission of such a request is required by claim 9. The examiner has failed to point to any disclosure in the cited art of “configuring the appliance to a first configuration” according to (at least a portion of) first configuration data, and “reconfiguring the appliance to a second configuration” according to (at least a portion of) second configuration data, as required by claim 9. Given at least the foregoing differences between claim 9 and claim 14, detailed consideration of claim 9 separate from claim 14 is warranted, since the rejection of claim 14 does not establish the presence of all elements of claim 9 in the cited art.

Moreover, the reasoning advanced by the examiner to combine the teachings of Venkatraman with Tan and Horn – namely, “for the purpose of equipping a smartcard with web server access abilities⁹¹” – is inapposite to Applicant’s claim 5, since such claim fails to recite any smart card. Indeed, the background section of the present application specifically describes the need to overcome difficulties in adapting appliance without having to support complex service infrastructures such as required by smart card systems⁹². Given the lack of presence of any smart card in Applicant’s claims, and the teaching in the present application to avoid use of smart cards, the reasoning advanced by the examiner to support combination of Venkatraman with Tan and Horn lacks any rational underpinning the conclusion of obviousness, as required by *KSR, supra*, to support the conclusion of obviousness.

⁹⁰ See April 1, 2009 Office Action, page 5.

⁹¹ See April 1, 2009 Office Action, page 4.

⁹² Specification, pg. 4, ll. 18-21.

Accordingly, because the rejection of claim 9 is not supported by any comparison to the cited art or related reasoning, the rejection of claim 9 is improper and should be reversed⁹³. Since dependent claims inherently include all the features of the claims on which they depend, the rejections of claims 7, 10, 12-13, 21, and 24-25 should be reversed for at least the same reasons as articulated in connection with claim 5.

C. The Cited Art Fails to Disclose All Elements of Applicant's Claim 9, 7, 10, 12-13, 21, and 24-25

Despite various differences between independent claims 9 and 14, claim 9 was rejected in the April 1, 2009 Office Action with reference to dependent claim 16 (which depends from claim 14). Specifically, the examiner stated:

“Claim 9 contains limitations that are substantially similar to [dependent] claim 16, and is therefore rejected under the same basis.”⁹⁴

Independent claim 9 recites, *inter alia*:

- receiving, at the appliance, first access data from memory of a first remote device, the first access data providing network access to first configuration data corresponding to a first set of user preferences on an external network;
- receiving at the appliance at least a portion of the first configuration data via the network access;
- configuring the appliance to a first configuration in accordance with the at least a portion of the first configuration data;
- wherein receiving the at least the portion of the first configuration data includes:
 - receiving first relay data responsive to an external network server identified in the first access data, and
 - receiving the at least a portion of the first configuration data made accessible via the network access by the first relay data.

⁹³ See MPEP 2144 (“*Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103*”), citing *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985); *KSR International Co. v. Teleflex Inc.*, 127 S.Ct 1727, 167 L.Ed.2d 705, 82 USPQ2d 1385 (April 30, 2007).

⁹⁴ See April 1, 2009 Office Action, page 5.

At a minimum, the foregoing elements of claim 9 in combination are neither taught nor suggested by Venkatraman, Tan, and Horn.

As discussed previously, Venkatraman's web browser 40 is provided to "access[] and control the device 10 via the network 30 by accessing the device home page 18, the loader web page 28, and the register interest web page 29 using HTTP protocols⁹⁵," and Venkatraman's web server 50 provides software elements, software updates, and package files identifying addresses of one or more software components to be loaded or installed. Neither Venkatraman's web browser 40 nor Venkatraman's web server 50 embody an external server or first remote device as recited in claim 9. Although Venkatraman's web browser and web server provide certain access and addressing functionality, the scope of Venkatraman is limited to providing access to a device via a device home page, not to reception of first relay data responsive to an external network server identified in the first access data, or reception of first configuration data made accessible via the network access by the first relay data, as recited in Applicant's claim 9.

Neither Tan nor Horn disclose any external server or first remote device as recited in Applicant's claim 9, let alone reception of first relay data responsive to an external network server identified in the first access data, or reception of first configuration data made accessible via the network access by the first relay data, as recited in Applicant's claim 9.

It is further noted that claim 9 specifically requires "configuring the appliance to a first configuration" according to (at least a portion of) first configuration data, and "reconfiguring the appliance to a second configuration" according to (at least a portion of) second configuration data. No reconfiguration utilizing second configuration data is disclosed or suggested by any of Venkatraman, Tan, or Horn.

Based on the foregoing, none of Venkatraman, Tan, or Horn, whether alone or in combination⁹⁶, disclose all features of claim 9. Accordingly, withdrawal of the rejection of claim 9 is warranted, and is respectfully requested. Because dependent claims inherently include all of the features of the claims on which they depend⁹⁷, dependent claims 7, 10, 12-13, 21, and 24-25 depending from claim 9 are likewise distinguished over Venkatraman, Tan, and Horn, such that reversal of the rejections of such dependent claims is warranted, and is respectfully requested.

⁹⁵ See Venkatraman, col. 4, ll. 43-48 and col. 3, ll. 20-30.

⁹⁶ Applicant hereby does not concede that Venkatraman is properly combinable with either Tan or Horn.

⁹⁷ 35 U.S.C. 112, fourth paragraph.

**IV. NONE OF CLAIMS 22-23 ARE OBVIOUS UNDER 35 U.S.C. 103 OVER
VENKATRAMAN IN VIEW OF TAN, HORN, AND HANKO**

Dependent claims 22-23 were rejected based on a hypothetical combination of Venkatraman with Tan, Horn, and Hanko. Hanko has been cited by the examiner as disclosing “reconfiguring the appliance to a first configuration [when] the smartcard is removed from the appliance⁹⁸.” Claims 22-23 depend (whether directly or indirectly) from independent claim 9. Because dependent claims inherently include all of the features of the claims on which they depend⁹⁹, claims 22-23 are distinguished over Venkatraman, Tan, and Horn for the same reasons as articulated hereinabove with respect to independent claim 9. Hanko fails to remedy the above-identified deficiencies of Venkatraman, Tan, and Horn in disclosing all elements of independent claim 9. Accordingly, reversal of the rejections of dependent claims 22 and 23 under 35 U.S.C. 103 is warranted, and is respectfully requested.

⁹⁸ April 1, 2009 Office Action, page 7.

⁹⁹ 35 U.S.C. 112, fourth paragraph.

CONCLUSION

For the reasons presented above, the rejections of claims 5, 7, 9, 10, and 12-25 under 35 U.S.C. § 103 should be reversed.

Respectfully submitted,

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Enclosures:

- **Claims Appendix**
- **Evidence Appendix**
- **Related Proceedings Appendix**

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1-4. (Canceled)

5. (Previously presented) An appliance, comprising:

a controller and a receiver connected thereto, being effective to receive a device identifier from a remote communications device; and

a network interface connectable to an external relay server corresponding to the device identifier; the controller being configured to:

transmit data corresponding to the device identifier to the relay server,
receive a profile address in response from the relay server,
transmit a request to an external profile server at the profile address,
receive one or more user preferences from the profile server, and
control the appliance based on the one or more user preferences.

6. (Canceled)

7. (Previously presented) The method of claim 9, wherein each of the first remote device and the second remote device corresponds to a portable device.

8. (Canceled)

9. (Previously presented) A method of controlling the operation of an appliance, the method comprising:

receiving, at the appliance, first access data from memory of a first remote device, the first access data providing network access to first configuration data corresponding to a first set of user preferences on an external network;

receiving at the appliance at least a portion of the first configuration data via the network access; configuring the appliance to a first configuration in accordance with the at least a portion of the first configuration data;

receiving, at the appliance, second access data to the appliance from a memory of a second remote device, the second access data providing network access to second configuration data corresponding to a second set of user preferences on the external network;

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receiving at the appliance at least a portion of the second configuration data via the network access; and

reconfiguring the appliance to a second configuration in accordance with the at least a portion of the second configuration data,

wherein:

receiving the at least the portion of the first configuration data includes:

receiving first relay data responsive to an external network server identified in the first access data, and

receiving the at least a portion of the first configuration data made accessible via the network access by the first relay data; and

receiving the at least the portion of the second configuration data includes:

receiving second relay data responsive to an external network server identified in the second access data, and

receiving the at least a portion of the second configuration data made accessible via the network access by the second relay data.

10. (Previously presented) The method of claim 9, wherein each of the first and second remote devices corresponds to a radio frequency identification device.

11. (Canceled)

12. (Previously presented) The method of claim 10, wherein delivering the first and second access data includes co-locating the radio frequency identification device with the appliance.

13. (Previously presented) The method of claim 9, wherein the first configuration data includes configuration data relating to the appliance and configuration data relating to another type of appliance.

14. (Previously presented) A method of controlling an appliance, the method comprising:

receiving, at the appliance, an address of an external relay server from a remote device,

transmitting, from the appliance, a first request to the relay server,

receiving, at the appliance, a profile address from the relay server, based on the first request,

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transmitting, from the appliance, a second request to an external profile server corresponding to the profile address,

receiving, at the appliance, user preference data from the profile server, based on the second request, and

controlling the appliance in accordance with the user preference data.

15. (Previously presented) The method of claim 14, wherein the remote device is a radio-frequency identification device that transmits the address associated with the relay server.

16. (Previously presented) The method of claim 14, further including:

receiving, at the appliance, an address associated with an other relay server from another remote device,

transmitting, from the appliance, a third request to the other relay server, based on the address associated with the other relay server,

receiving, at the appliance, an other profile address from the other relay server,

transmitting, from the appliance, a fourth request to an other profile server corresponding to the other profile address,

receiving, at the appliance, other user preference data from the other profile server, based on the fourth request, and

controlling the appliance in dependence upon at least a portion of the other user preference data.

17. (Previously presented) The method of claim 14, wherein the address of the relay server includes a Uniform Resource Locator (URL) that is stored at the remote device.

18. (Previously presented) The appliance of claim 5, wherein the communications device is a wireless device that is remote from the appliance.

19. (Previously presented) The appliance of claim 18, wherein the device identifier includes a Uniform Resource Locator (URL) associated with the relay server.

20. (Previously presented) The appliance of claim 5, wherein the controller is configured to determine an address of the relay server based on the device identifier.

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21. (Previously presented) The method of claim 9, wherein reconfiguring the appliance includes creating a composite of the portion of the first configuration data and the portion of the second configuration data.

22. (Previously presented) The method of claim 12, further including reconfiguring the appliance to the first configuration after removal of the second remote device from a vicinity of the appliance.

23. (Previously presented) The method of claim 22, further including measuring a time duration after the removal of the second remote device, and wherein reconfiguring the appliance to the first configuration occurs when the time duration exceeds a predefined persistence period.

24. (Previously presented) The method of claim 9, wherein the first access data includes a Uniform Resource Locator (URL) associated with a relay server.

25. (Previously presented) The method of claim 24, wherein the second access data includes an other Uniform Resource Locator (URL) associated with an other relay server.

EVIDENCE APPENDIX

No evidence has been submitted pursuant to 37 CFR §§ 1.130, 1.131, or 1.132 in the application that is the subject of the present appeal, and appellant is not relying on any evidence by the examiner in the record. Accordingly, no evidence is identified in this Evidence Appendix.

RELATED PROCEEDINGS APPENDIX

There exist no other prior or pending appeals, interferences or judicial proceedings known to appellant, appellant's attorney, or the assignee that may be related to, direct affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal. Accordingly, there exist no decisions rendered by a court or the Board in any related proceeding, such that no related proceedings are identified in this Related Proceedings Appendix.